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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,428	10/11/2001	Benny B. Johansen	RXSD 1017-1	9076

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EXAMINER	
MCCROSKY, DAVID J	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No.	Applicant(s)	
	09/975,428	JOHANSEN ET AL.	
	Examin r	Art Unit	
	David J. McCrosky	3736	

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The disclosure is objected to because of the following informalities: the application numbers left blank on p. 1 must be filled. Appropriate correction is required.

Claim Objections

Claims 1 and 13 are objected to because of the following informalities: it is unclear whether the stimulus referred to in limitation c) is the same stimulus referred to in the preamble. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 12 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Horn. Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet. See abstract. The volume control on the computer is set, a stimulus is presented and the user strikes a

keyboard or mouse to indicate whether the user heard the stimulus. This procedure is done to establish a standard for the user's system. See col. 6, ll. 14-53.

Claim Rejections - 35 USC § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horn as applied to claim 1 above. Horn discloses the claimed invention as recited for claim 1 but does not disclose transferring the computer program via email. It would have been an obvious matter of design choice to modify the method of Horn by sending the program through email since Applicant has not disclosed that using email solves any stated problem or is for any particular purpose and it appears that the method would perform equally well with any type of data transfer.

Claims 5-11 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn as applied to claim 1 above, and further in view of admitted prior art (Admission). Horn discloses the invention as recited for claim 1. While disclosing the importance of controlling a user's computer and its sound during a hearing test, Horn does not disclose the detail of controlling sound. Admission discloses the details of controlling sound. In particular the channel balance and volume of an audio source, such as a wave file, are taught. See Applicant's Figure 1 and Specification p. 2, l. 15 to p. 3, l. 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the method and computer program of Horn to use the details for controlling sound, as taught by Admission, to establish a standard for the user's system.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the settings since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

In regards to claims 8-11, 25 and 26, the combination accomplishes the same task as claimed but does not teach a plurality of audio sources. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add another audio source, since it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Claims 13-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn in view of Myer et al. Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet. See abstract. The volume control on the computer is set, a stimulus is presented and the user strikes a keyboard or mouse to indicate whether the user heard the stimulus. This procedure is done to establish a standard for the user's system. See col. 6, ll. 14-53. Horn does not disclose storing a value of volume control and resetting to the stored value. However, Myer et al teach that it is well known in the art to control an audio amplifier over a network by saving volume settings and resetting to these levels. See col. 17, ll. 33-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and computer program of Horn with

storing and resetting features, as taught by Myer et al, to return to the user's desired settings.

Regarding claim 15, the above combination discloses the claimed invention except for transferring the computer program via email. It would have been an obvious matter of design choice to modify the method of Horn by sending the program through email since Applicant has not disclosed that using email solves any stated problem or is for any particular purpose and it appears that the method would perform equally well with any type of data transfer.

Claims 16-20 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn in view of Myer et al as applied to claims 13 and 27 above, and further in view of admitted prior art (Admission). Horn and Myer et al teach a method and computer program as recited for claims 13 and 27. The combination does not disclose the detail of controlling sound. Admission discloses the details of controlling sound. In particular the channel balance and volume of an audio source, such as a wave file, are taught. See Applicant's Figure 1 and Specification p. 2, l. 15 to p. 3, l. 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the method and computer program of Horn and Meyer et al to use the details for controlling sound, as taught by Admission, to establish a standard for the user's system.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the settings since it has generally been recognized that merely providing an automatic means to replace a manual activity which

accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

In regards to claims 19, 20, 31 and 32, the Horn, Myer et al and Admission accomplish the same task as claimed but does not teach a plurality of audio sources. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add another audio source, since it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 7, 12, 22 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 11-14, 18, 19 and 21 of copending Application No. 09/975,047 in view of Horn. The copending application claims a hearing test computer program downloaded through the Internet and executed on a computer to generate an audio stream. The

copending application does not claim volume control of the audio stream. However, Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet. See abstract. The volume control on the computer is set, a stimulus is presented and the user strikes a keyboard or mouse to indicate whether the user heard the stimulus. This procedure is done to establish a standard for the user's system. See col. 6, ll. 14-53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and computer program of the copending application with the volume control of Horn to establish a standard for the user's system.

This is a provisional obviousness-type double patenting rejection.

Claims 13-15, 18, 21, 27 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 77-14, 18, 19 and 21 of copending Application No. 09/975,047 in view of Horn and Myer et al. The copending application claims a hearing test computer program downloaded through the Internet and executed on a computer to generate an audio stream. The copending application does not claim volume control of the audio stream. However, Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet. See abstract. The volume control on the computer is set, a stimulus is presented and the user strikes a keyboard or mouse to indicate whether the user heard the stimulus. This procedure is done to establish a standard for the user's system. See col. 6, ll. 14-53. Horn does not disclose storing a value of volume control and resetting to the stored value. However,

Myer et al teach that it is well known in the art to control an audio amplifier over a network by saving volume settings and resetting to these levels. See col. 17, ll. 33-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and computer program of the copending application with the volume control of Horn and with storing and resetting features, as taught by Myer et al, to establish a standard for the user's system and to return to the user's desired settings.

This is a provisional obviousness-type double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Naidoo discloses an Internet based screening tool for hearing loss. Hou discloses on-line hearing loss testing. Eldon adjusts the output of a soundcard in a computer to test hearing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on 703-308-3130. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DJM

ERIC F. WINAKUR
PRIMARY EXAMINER